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10/643,500

08/19/2003

James G. Chaussec

J-3789

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28165 7590 03/27/2007  
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EXAMINER

CHANNAVAJJALA, LAKSHMI SARADA

ART UNIT

PAPER NUMBER

1615

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|-----------|---------------|
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3 MONTHS

03/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/643,500

Applicant(s)

CHAUSSEE ET AL.

Examiner

Lakshmi S. Channavajjala

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 December 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

Receipt of amendment and remarks all dated 12-22-06 is acknowledged.

Claims 1-24 are pending in the instant application.

The following rejection of record dated 9-27-06 has been maintained:

#### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,902,225 to Monson in view of EP 170 269 (EP) (both submitted on PTO-1449).

Monson teaches (applicants admit on page 1 of the instant specification) a post foamable skin or hair compositions composition comprising a concentrate and a diluent, of which the former reads on the instant "intermediate" (see examples). Examples 1-9 reveal that the concentrate of Monson comprises surfactants such as decyl polyglucoside, triethanolamine, isobutene, isopentane (read on instant propellants), Carbopol (polymer), an emollient such as dimethicone copolyol (reads on the moisturizer of claim 1 and 17) and other additives. The diluent of the composition contains sodium bicarbonate and citric acid (examples). The ratio of citric acid to bicarbonate taught by Monson is within the range of instant claim 13. Monson fails to teach the claimed ratios or the percentages of the blend capable of generating carbon dioxide, the blend of polymer, ratios of the propellants isopentane and isobutene or the claimed moisturizers. However, generally, differences in concentration or temperature

Art Unit: 1615

will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration or temperature is critical. "Where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). Accordingly, optimizing the percentages or ratios of the blend capable of generating carbon dioxide, and the ratios of the propellants isopentane and isobutene. While Monson does not teach a blend of polymers, the reference suggested several polymers for adjusting the viscosity of the composition (col. 7, L 35-44) and accordingly, in the absence of any unexpected advantage, one of an ordinary skill in the art would have employed one or more polymers for adjusting the viscosity of the composition at the desired level. Monsoon further teaches the composition as a post-foaming preparation that is present in a container, wherein the pressure of the composition when present in the composition is between 10-60 psig and includes the claim limitations of 15 and 16.

Monson fails to teach the claimed lactic acid and specific moisturizers.

EP also teaches skin or hair compositions in the form of shampoos, conditioners etc., similar to Monson. The composition of EP also comprises a substance capable of emitting carbon dioxide emission, in addition to surfactants, vitamin E acetate (reads on claimed moisturizers of claims 2 & 19), lactic acid, lactate, etc (see examples 9, 11, 12 etc), the entire composition being present in a container. EP teaches addition of organic acids such as citric acids, lactic acids as pH modifiers to the final composition (pages 8

Art Unit: 1615

& 9). Thus both Monson and EP are directed to analogous art and It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980). Accordingly, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to include lactic acid and vitamin E acetate of EP in the post-foaming composition of Monson because EP suggests that the acids such as lactic acid provide buffering activity and both the references desire the presence of components such as emollients, skin treatment or conditioning agents such as glycerin, humectants, antibacterial agents, vitamins etc. Thus both Monson and EP are directed to analogous art and It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art." In re Kerkhoven, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980).

### ***Response to Arguments***

Applicant's arguments filed 12-22-06 have been fully considered but they are not persuasive.

Applicants argue that Monson is deficient in disclosing lactic acid as a component of its composition, the Monson composition does not result in the surprising quality of small bubbles upon dispensation, that Monson and the

Art Unit: 1615

desirability of smaller versus larger bubbles in a skin preparation product is discussed in applicants' specification. It is argued that in a comparative assessment, applicants demonstrate a surprising increase in the beneficial characteristic of applicants' invention relating to bubble size, that "the size and numbers of bubbles produced [by a skin preparation composition] are important factors for use as a lubricant and humectant. The smaller the bubbles, the more surface area is present to hold water to the skin of a user and thus easier it is [to] shave." In this regard, applicants discuss that the photos show that "a composition according to the present invention dispensed at 85 psig results in a greatly increased number of bubbles and a small bubble size both throughout the exposure time." Applicants noted that the photos of the dispensed composition using 40 psig also showed the advantage of substantially smaller bubble sizes in their dispensed composition relative to the Monson composition.

Applicants' arguments are not persuasive because instant claims do not recite the bubbles or bubble sizes or the pressure employed to dispense the composition. Instead the claims are only directed to a composition. With respect to the teaching of lactic acid, examiner admits Monson does not teach lactic acid, but EP reference of record provides a teaching for lactic acid.

It is argued that the Monson patent includes instruction that clearly leads the reader away from the composition taught by applicants, for example: The blend of bicarbonate and citric acid in Monson constitutes no more than 3.5% of Monson's diluent, as noted in Monson's examples, as opposed to the applicants' blend constitutes over a 10-fold greater proportion of their diluent. This argument is not persuasive because instant claims 1-16 do not recite the amounts of the diluent. Moreover, claim 16 does not state what the actual blend is and therefore, the argument regarding unexpected advantage is not commensurate with the scope of the claims.

Applicants' arguments regarding the final concentration of the diluent in the instant versus that of Monson's composition is moot because instant claims do not specify the percentages argued. Further, a comparison between instant and that of Monson's is not proper because arguably Monson lacks lactic acid and therefore the composition do not have the same constituents let alone same percentages. On the other hand, instant rejection is over not just Monson and instead over a combination of Monson and EP.

Art Unit: 1615

While applicants argue against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants argue that Monson's deficiencies cannot be overcome when considered in combination with EP 170269 ("EP") because EP teaches dermatological products for the treatment and is not analogous art to applicants' invention. It is argued that in contrast, applicants' invention includes no medicament of any sort. The argument is not persuasive because instant "comprising" language allows for the presence of medicaments or skin treatment agents of EP and besides skin preparation compositions do not in any way reflect that medicaments should not be included. Further, instant claimed vitamins, aloe vera etc (claim 2) provide dermatological and therapeutic effect in terms of antioxidant and moisturizing effects respectively.

It is argued that for the combination of elements found in separate references to support the rejection, there must be "reason, suggestion, or motivation to make that combination and that EP teaches the use of lactic acid as a "pH modifier". However, EP clearly states that the compositions prepared in pressure resistant containers containing carbon dioxide (pages 10-11) and that a pH modifier (applicants admit that EP teaches lactic acid as a pH modifier) to generate carbon dioxide. Thus, with respect to lactic acid the teachings of EP are no different from that of instant. Hence EP provides the requisite motivation and suggestion to add lactic acid to the composition of Monson.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

Art Unit: 1615

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 7.00 AM -4.00 PM.

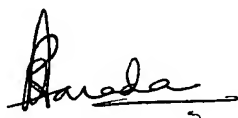
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 1615

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AU 1615  
March 21, 2007



LAKSHMI S. CHANNAVAJJALA  
PRIMARY EXAMINER